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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/204,390	12/02/1998	DEBORAH EVERLING	P/2167-61	5465

7590 11/19/2004

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EXAMINER

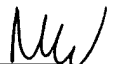
FULTS, RICHARD C

ART UNIT	PAPER NUMBER
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3628

DATE MAILED: 11/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/204,390	<b>Applicant(s)</b> EVERLING ET AL.	
	<b>Examiner</b> Richard Fults	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

A request for reconsideration was received with no amendments made to the claims. Accordingly claims 1-21 are being considered on their merits.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. Claims 1-21 are rejected under 35 USC 101 as the claimed invention is directed to non-statutory subject matter. For a claim to be statutory under 35 USC 101 the following two conditions must be met:

1) In the claim, the practical application of an algorithm or idea results in a useful, concrete, tangible result,

AND

2) The claim provides a limitation in the technological arts that enables a useful, concrete, tangible result.

As to the technology requirement, note MPEP Section IV 2(b). Also note *In re Waldbaum*, 173USPQ 430 (CCPA 1972) which teaches “useful arts” is synonymous with “technological arts”. In *Musgrave*, 167USPQ 280 (CCPA 1970), *In re Johnston*, 183USPQ 172 (CCPA 1974), and *In re Toma*, 197USPQ 852 (CCPA 1978), all teach a technological requirement.

The invention in the body of the claim must recite technology. If the invention in the body of the claim is not tied to technological art, environment, or machine, the claim is not statutory. *Ex parte Bowman* 61USPQ2d 1665, 1671 (BD. Pat. App. & Inter. 2001) (Unpublished).

### ***Claim Rejections - 35 USC § 103***

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-21 are rejected under 35 U.S.C. 103(a) as being anticipated by **Melchione** et al (U.S. Patent No. 5,930,764).

A method for processing transaction data comprising the steps of:

receiving transaction data, the transaction data containing account numbers (abstract, figs. 1-8, col. 1, lines 53-62, col.2, lines 20-37, col.7 lines, 23-59, col. 14, lines 47-65);

identifying non-issuer account numbers which represent accounts not issued by an issuer (col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67);

matching the identified non-issuer account numbers with account numbers representing (col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67);

account issued by the issuer (col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67, col.38, lines 55-60);

identifying a consumer associated with at least one of the identified non-issuer account numbers (col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67, col.38, lines 55-60);

**determining** if the identified consumer is a customer of the issuer, the customer having an issuer account number representing an issuer account issued by the issuer (col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67, col.38, lines 55-60);

linking the non-issuer account number of the customer with the issuer account number of the customer (col.44, lines 30-67);

maintaining a database containing issuer account numbers representing issuer accounts of customers of an issuer, and containing customer non-issuer account numbers representing non-issuer accounts of the customers (abstract, claims 1-3,

figs. 1-8, col. 1, lines 53-62, col.2, lines 20-37, col.7 lines, 23-59, col.14, lines 47-65, col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67, col.38, lines 55-60, col.44, lines 30-67);

adding the matched non-issuer account numbers to the database as customer non-issuer account numbers (abstract, claims 1-3, figs. 1-8, col. 1, lines 53-62, col.2, lines 20-37, col.7 lines, 23-59, col.14, lines 47-65, col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67, col.38, lines 55-60, col.44, lines 30-67);

updating the historical transaction data in the database by adding received transaction data, which contains matched non-issuer account numbers (abstract, claims 1-3, figs. 1-8, Col. 1, lines 53-62, col.2, lines 20-37, col.7 lines, 23-59, col.14, lines 47-65, col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67, col.38, lines 55-60, col.44, lines 30-67);

performing queries on the database (col.1, lines 53-62, col.2, lines 20-37, col.7 lines, 23-59, col. 14, lines 47-65);

determining the use of the non-issuer account by the customer in response to a result of the query, marketing services of the issuer to the customer in response to the determined use by the customer, eliminating transaction data account number issued by the issuer, and eliminating transaction data that contains data representing duplicate non-issuer account number (abstract, claims 1-3, figs. 1-8, col.], lines 53-62, col.2, lines 20-37, col.7 lines, 23-59, col.14, lines 47-65,

col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67, col.38, lines 55-60, col.44, lines 30-67); and

receiving new transaction data, the new transaction data representing new credit transactions and comprising records containing at least account numbers of accounts which initiated the new credit transactions (claims 1-3, figs. 1-8, col. 1, lines 53-62, col.2, lines 20-37, col.7 lines, 23-59, col.14, lines 47-65, col.20, lines 10-16, col.23, lines 1-17, col.35, lines 29-67, col.38, lines 55-60, col.44, lines 30-67). Melchione uses different words to describe the applicant's invention.

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3. Claims 1-21 merely describe the old and well known practice of sorting and matching data within a database using user defined criteria. Because it was so well known it would have been obvious to one skilled in the art at the time of the invention to have been aware of those facts and use them in practicing this invention.

### **Response to Arguments**

4. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's request for a reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. This action takes its place.


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Fults whose telephone number is 703-305-5416. The examiner can normally be reached on weekdays from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough, can be reached on (703)-305-0505. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

  
RCF

11/9/2004

  
FRANTZY POINVIL  
PRIMARY EXAMINER  
Au 3628